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BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, IL 60610

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In re Application of
Fred L. Starkey
Application No. 09/758,668
Filed: January 11, 2001
Attorney Docket No. 1981/637

OFFICE OF PETITIONS
: **DECISION ON PETITION**
: **UNDER 37 CFR 1.78(a)(6)**
:
:

This is a decision on the petition under 37 CFR 1.78(a)(6), filed May 18, 2004, to accept an unintentionally delayed claim under 35 U.S.C. § 119(e) for the benefit of a prior-filed provisional Application No. 60/176,165, filed January 14, 2000, the amendment of which is embodied in the instant petition.¹

The petition is **DISMISSED AS MOOT**.

A petition under 37 CFR § 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000.

Along with the instant petition under 37 CFR § 1.78(a)(6), petitioner has submitted an amendment to the first sentence of the specification following the title to include a reference to the prior-filed application.

The instant pending nonprovisional application was filed on January 11, 2001, and was pending at the time of filing of the instant petition. Reference to the prior-filed application was made in the declaration filed with the instant application.

The current procedure where a claim for priority under 37 CFR 1.78(a)(6) is not included in the first sentence of the specification or in an ADS but does appear either in the oath or declaration or a transmittal letter filed with the application and the Office notes the claim for priority, no petition will be required to accept a late claim for priority. This is because the application would have been scheduled for publication on the basis of the information concerning the claim submitted elsewhere in the application within the time period set forth in 37 CFR § 1.78(a)(5)(ii). However, on the other hand, if the USPTO does not note the claim for priority to the prior-filed application(s) set forth in the oath or declaration or transmittal letter submitted with the application, a petition will be required to accept a late claim for priority under 37 CFR § 1.78(a)(6).² In the instant case, the Office noted the claim for priority of the above-noted, prior-

¹ Petitioner is advised that the amendment must be included in a separate paper, since different matters are handled by different branches of the Office. *Note* 37 CFR 1.4(c)) and 37 CFR 1.121.


² *Note* MPEP 201.11 (V), page 200-75 (Rev. 1. Feb. 2004 and 66 Federal Register 67087 at 67089 (Dec. 28, 2001), effective December 28, 2001.

filed application in the declaration filed with the application, as shown by its inclusion on the filing receipt.

In view of the above, the \$1,370 petition fee submitted is unnecessary and will be credited to petitioner's deposit account in due course.

Any questions concerning this decision on petition may be directed to Wan Laymon at (571) 272-3220. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This matter is being referred to Publishing Division to be processed into a patent.


Frances Hicks
Lead Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy